

**REMARKS**

With this Amendment, Applicant cancels Claim 28. Therefore, Claims 1-15 and 23-27 are all the claims pending in the application.

**Formal Matters**

The Examiner has reviewed and considered the references cited in the Information Disclosure Statement filed June 21, 2004.

§102 Rejections. Claims 23-26 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Cox et al., U.S. Patent No. 6,256,515 (“Cox”). Claims 27-28 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Weinman Jr., U.S. Patent No. 6,658,455 (“Weinman”). Applicant respectfully traverses these rejections as discussed below.

§103 Rejections. Claims 1-2, 5-6, 8, 12, and 14-15 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Fujii et al., GB 2,251,357 (“Fujii”), in view of Cox. Claims 3-4, 9-10, and 13 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Fujii, in view of Cox and Weinman. Claim 7 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Fujii, in view of Cox and Fernandez et al., WO 99/65256 (“Fernandez”). Claim 11 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Fujii, in view of Cox and Beach, U.S. Publication 2001/0055283 (“Beach”). Applicant respectfully traverses these rejections as discussed below.

Applicant notes that the Examiner incorrectly refers to Fernandez (WO 99/65256) as Henry. Applicant notes that Henry is the name of the agent and that Fernandez is the name of the inventor of WO 99/65256. Hereinafter, Applicant refers to WO 99/65256 as "Fernandez."

**Claims 23-26**

Regarding the Examiner's §102(e) rejection of Claims 23-26, Applicant respectfully submits that Cox fails to disclose or suggest each of the limitations of the present invention as recited in Claims 23-26.

Claim 23. As discussed in the specification, the present invention is directed, in part to blocking the reception of a non-permitted call at a mobile phone without wastefully utilizing the resources necessary to connect a call to the mobile phone in order to determine from a telephone directory stored in the mobile phone whether or not reception of the call is permitted. In addressing this problem, the present invention includes, in part, referring to a directory of records when a call is requested, in order to determine whether the call is permitted and connecting the call if the connection is permitted and discarding the call if the connection is not permitted, as claimed.

The Examiner refers to the Abstract; col. 3, lns. 5-37; and col. 4, lns. 42-62 as teaching this feature. Applicant submits that this feature is not disclosed or suggested by Cox, and neither is it inherent to the disclosure of Cox.

In contrast to the invention of the present application, Cox is directed to a call management system to manage and restrict the use of controlled wireless phones issued for

official purposes. (Cox, Abstract). Cox describes that when a call is placed *from* a controlled wireless phone, a determination is made as to whether the call is to an approved number or not. If the call is approved, it is completed normally, and if it is not approved, the caller is prompted to provide an access code in order to complete the call. (Abstract; col. 3, lns. 5-37; col. 4, lns. 42-62). Therefore, Cox is directed to a method of controlling calls *from* a controlled mobile phone, and fails to disclose any specific method for controlling calls directed *to* a mobile phone, as is recited in Claim 23.

Cox generally notes that “[t]he described services may also, of course, be used to control calls to such devices or telephones.” (Col. 4, lns. 16-18). However, the methods disclosed in Cox for controlling calls *from* a controlled mobile phone, namely requiring the caller to enter an access code before a call to a non-pre-approved number can be placed, are not immediately applicable to controlling calls directed *to* a controlled mobile phone. Further, Cox fails to disclose, in response to receiving a communication request *from* a contact, referring to a directory of records of contacts in order to determine if a connection with the contact is permitted.

Applicant further submits that this limitation is not inherently disclosed in Cox. Evidence of inherency in a reference “must make it clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of

ordinary skill.”<sup>1</sup> “Inherency, however may not be established by probabilities or possibilities.

The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”<sup>2</sup>

Even if the prior art reference could have equally been used or made with only two possibilities, a patent claim which claims one of the two possibilities will not be anticipated because that limitation was not “necessarily” present in the prior art disclosure.<sup>3</sup>

Thus, even if it were assumed in this case that it would be possible to modify the system of Cox in order to control calls directed to a controlled phone, as recited in Claim 23 of the present invention, such a disclosure is insufficient to meet the high burden of anticipation, because there may be any number of ways in which a person skilled in the art could manipulate the system described in Cox in order to control calls placed to a controlled phone, none of which is “necessarily present” in the Cox disclosure.

Therefore, for at least the above reasons, Applicant submits that Cox fails to anticipate Claim 23, and respectfully requests that the Examiner’s §102 rejection of Claim 23 be reconsidered and withdrawn.

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<sup>1</sup> *Continental Can Co. USA Inc. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991) (*emphasis added*).

<sup>2</sup> *Id.* (citing *In re Oelrich*, 666 F.2d 578, 581 (Fed. Cir. 1981) (*quoting Hansgirk v. Kemmer*, 102 F.2d 212, 214 (C.C.P.A. 1939))) (*emphasis in original*); see also *Scaltech Inc. v. Retec/Tetra L.L.C.*, 51 U.S.P.Q.2d 1055, 1059 (Fed. Cir. 1999); and *In re Robertson*, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999).

<sup>3</sup> See *Finnigan Corp. v. I.T.C.*, 51 U.S.P.Q.2d 1001, 1009-10 (Fed. Cir. 1999) (holding that a prior art reference that disclosed a set-up for performing only resonance or nonresonance ejection was  
...(footnote continued)

Claims 24-26. Applicant submits that Claims 24-26 are patentable at least by virtue of their dependence on Claim 23.

Applicant further submits that Cox fails to disclose or suggest wherein a communication request is an e-mail, as recited in Claim 26. The Examiner refers to col. 9, lns. 21-26 of Cox to disclose this limitation. Indeed, Applicant notes that col. 9, lns. 21-26 includes the only reference to e-mail in the Cox disclosure. However, the Examiner is mistaken in his understanding of this portion of Cox. In fact, this portion of Cox discusses reports which may be generated from the call records of a controlled mobile phone. Cox discloses that such a record may be transmitted to an organization in hard-copy or in electronic form, as via an e-mail message. There is no disclosure in the cited portion of Cox or anywhere else in the reference of the claimed control method, wherein the communication request is an e-mail, as recited in Claim 26.

Therefore, for at least these reasons, Applicant submits that Claims 24-26 are not anticipated by Cox and respectfully request that the Examiner's §102 rejection of these claims be reconsidered and withdrawn.

**Claim 27**

Regarding the Examiner's §102(e) rejection of Claim 27, Applicant respectfully submits that Weinman fails to disclose or suggest each of the limitations of the present invention as recited in Claim 27.

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insufficient to show, clearly and convincingly, that nonresonance ejection was inherently taught by the prior art reference).

Applicant submits that Weinman fails to disclose or suggest transmitting, via an antenna in a mobile phone, as claimed, records stored in the mobile phone to a directory server in a network.

The Examiner refers to col. 4, lns. 30-49; col. 5, lns. 33-35; col. 8, lns. 19-37; col. 9, lns. 32-50; and col. 13, lns. 60-65 as disclosing this feature of the present invention.

The cited portions of Weinman refer to two types of data stored in a mobile phone: a personal directory list (PDL) and a rule-base. The PDL is a directory into which is downloaded information relating to contacts specific to or specified by a user. The PDL may be located within the user's customer premise equipment (CPE), or alternately, within a personal network directory (PND) within an access network. (Col. 8, lns. 1-5). The rule-base is a series of rules, dictated by a user, which regulates information provided to the user. (Col. 8, lns. 13-15). As with the PDL, the rule-base may be located within the CPE, or alternately, within the PND in the access network. (Col. 8, lns. 15-19).

As discussed, either or both of the PDL and the rule-base may be located in the CPE, stored in the memory 205 of the CPE (Fig. 2). The CPE, as disclosed, may be any of "a cellular telephone, a digital telephone, a personal communications device, a land-line telephone, a personal or laptop computer, a video telephone, a one-way or two-way pager, a pay phone, and/or any other suitable one way or two way communications device and/or system." (Col. 5, lns. 33-43; col. 13, lns. 41-46; Fig. 1, CPE 101-1 to 101-n).

While the PDL and/or the rule-base may be stored in the memory of the CPE, there is no disclosure of inputting a record into either the PDL or the rule-base within the CPE memory. There is a disclosure of the ability of a user to edit and/or update entries in the rule-base through the CPE. (Col. 9, Ins. 41-45). However, even assuming, *arguendo*, that this was equivalent to inputting a record into a storage unit in a mobile phone, there is no disclosure or suggestion in Weinman of transmitting records stored in the storage unit of a mobile phone to a directory server in a communication control network. First, as discussed above, Weinman describes that the rule-base may be located *either* in the CPE *or* within the PND within the access network. There is no disclosure or teaching that a rule-base stored in the CPE is transmitted to the PND. Second, even assuming, *arguendo*, that a rule base stored in the CPE were to be transmitted to the PND, there is no disclosure or teaching that such a transmission would be via an antenna.

The Examiner asserts that the antenna is inherent. (Office Action, p. 3). As discussed above, evidence of inherency in a reference “must make it clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill,”<sup>4</sup> and inherency may not be established by probabilities or possibilities.<sup>5</sup> Therefore, even if it were assumed that a rule-base stored in the CPE were

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<sup>4</sup> *Continental Can Co. USA Inc. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991) (*emphasis added*).

<sup>5</sup> *Id.* (citing *In re Oelrich*, 666 F.2d 578, 581 (Fed. Cir. 1981) (quoting *Hansgirk v. Kemmer*, 102 F.2d 212, 214 (C.C.P.A. 1939))) (*emphasis in original*); see also *Scaltech Inc. v. Retec/Tetra L.L.C.*, 51 U.S.P.Q.2d 1055, 1059 (Fed. Cir. 1999); and *In re Robertson*, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999).

transmitted to the PND, such a disclosure is insufficient to meet the high burden of anticipation, because, as disclosed, the CPE is not necessarily a wireless device, and therefore, does not necessarily transmit via an antenna.

Applicant further submits that Weinman fails to disclose or suggest uploading records to a directory server, thereby creating a replica directory of records. The only discussion in Weinman of replica data is the replication of the PND in order to partition the PND for multiple users. (Col. 13, lns. 11-26). There is no disclosure or teaching in Weinman of uploading records to a directory server, *thereby* creating a replica directory, as claimed.

Therefore, for at least these reasons, Applicant submits that Weinman fails to anticipate Claim 27 and respectfully request that the Examiner's §102 rejection of Claim 27 be reconsidered and withdrawn.

**Claims 1-2, 5-6, 8, 12, and 14-15**

Regarding the Examiner's §103(a) rejection of Claims 1-2, 5-6, 8, 12, and 14-15, Applicant respectfully submits that the cited combination of Fujii and Cox fails to teach or suggest each of the limitations of the present invention as recited in these claims.

Claim 1. Applicant submits that Claim 1 is patentable for at least the same reasons as presented above with respect to Claim 23.

The Examiner acknowledges that Fujii fails to teach or suggest "a communication control unit which refers to the directory to determine whether or not a requested connection of a contact to said mobile phone is permitted, and which transmits a response indicative of permission or



non-permission of the connection.” (Office Action, p. 5). Further, as discussed above, with respect to Claim 23, Cox also fails to teach or suggest this limitation.

Therefore, Applicant submits that Claim 1 is patentable over the cited combination of references and respectfully requests that the §103(a) rejection of Claim 1 be reconsidered and withdrawn.

Claims 2, and 5-6. Applicant submits that Claims 2 and 5-6 are patentable at least by virtue of their dependence on Claim 1.

Further, regarding Claims 2 and 5, Applicant submits that the cited combination of references fails to teach or suggest that a directory stored remotely to a mobile phone is a replica (duplicate) of a directory stored in a storage unit of a mobile phone. The Examiner relies on Fujii to teach this limitation. (Office Action, p. 5-6). Applicant submits that contrary to the assertion of the Examiner, Fujii specifically teaches away from storing a replica of data stored in a mobile phone. As described in Fujii, the memory of the radiotelephone device is limited, and therefore, the external device stores *excess* information which cannot be stored in the small memory of the radiotelephone device. Therefore, not only does Fujii fail to teach or suggest storing a replica of data stored in a mobile phone, it would be counterintuitive, given the disclosure of Fujii, to modify the disclosure in order to duplicate data stored in a mobile phone and additionally store it remotely to the phone.

Regarding Claim 6, the cited combination of references also fails to teach or suggest a non-permission flag or a switching apparatus, as claimed. The Examiner relies on Fujii, p. 12,

lns. 1-19 to teach this limitation. (Office Action, p. 6). This section of Fujii discloses subscriber information which is input into an electronic notebook, and which can be accessed ("recalled") by the user of the radiotelephone terminal in order to place a call. Contrary to the assertion of the Examiner, neither this portion, nor any other portion of Fujii teaches or suggests a non-permission flag or any ability to permit or decline any connection.

Therefore, for at least the above reasons, Applicant submits that Claims 2 and 5-6 are patentable over the cited combination of references and respectfully requests that the §103(a) rejection of these claims be reconsidered and withdrawn.

Claims 8 and 12. Applicant submits that Claims 8 and 12 are patentable over the cited combination of references for the same reasons as presented above with respect to Claims 2 and 5. As discussed, the combination of references fails to teach or suggest a replica directory stored in a directory server of a communication control network. Applicant submits, therefore, that the cited reference fail to teach or suggest a transmitting section of a mobile phone which transmits a directory to a directory server in a communication control network to be stored therein as a replica directory of records.

For at least these reasons, Applicant submits that Claims 8 and 12 are patentable over the cited combination of references and respectfully request that the §103(a) rejection of these claims be reconsidered and withdrawn.

Claims 14 and 15. Applicant submits that Claims 14 and 15 are patentable at least by virtue of their dependence on Claim 12, discussed above. Therefore, Applicant respectfully requests that the §103(a) rejection of these claims be reconsidered and withdrawn.

**Claims 3, 4, 9, 10, and 13**

Regarding the Examiner's §103(a) rejection of Claims 3, 4, 9, 10, and 13, Applicant respectfully submits that the cited combination of Fujii, Cox, and Weinman fails to teach or suggest each of the limitations of the present invention as recited in these claims.

Claims 3, 9, and 13. Regarding Claims 3, 9, and 13, Applicant submits that the cited combination of references fails to teach or suggest an edit flag, as claimed.

The Examiner acknowledges that Fujii in view of Cox fails to teach an edit flag. Therefore, the Examiner relies on the voice print tag of Weinman to teach this limitation. (Office Action, p. 7). As discussed in the specification of the present application, an edit flag indicates that a record has been edited. Applicant asserts that the voice tag of Weinman is not an edit flag.

Weinman describes that a voice tag "may be used to select an entry so as to, for example, add, retrieve, edit, or delete the corresponding information in the future." (Col. 8, lns. 56-59). However, a complete reading of Weinman makes it clear that the voice tag is used to encode certain records or certain commands with voice-activated operability. For example, a voice tag on the record for "Elizabeth Jones" may allow a user to access the record for Elizabeth Jones by speaking "Mom." (Col. 8, lns. 59-63). Similarly, a voice tag on a command may allow a user to assert that command by simply speaking it. For example, a voice tag on the edit command may

allow the user to perform the edit command by simply speaking “edit.” (Col. 8, ln. 66 through col. 9, ln. 18). Therefore, the voice tag may be used to select an entry, such as “Elizabeth Jones,” as discussed above, so as to be able to add, retrieve, edit, or delete the corresponding information at a later time, for example, by speaking “edit Mom” in order to edit the entry to Elizabeth Jones.

Therefore, Applicant submits that the voice tag of Weinman is unrelated to an edit flag, as claimed, and that the cited combination of references fails to teach or suggest an edit flag as recited in Claims 3, 9, and 13. Therefore, Applicant respectfully requests that the §103(a) rejection of Claims 3, 9, and 13 be reconsidered and withdrawn.

Claims 4 and 10. Applicant submits that Claims 4 and 10 are patentable at least by virtue of their dependence on Claims 3 and 9, respectively. Therefore, Applicant respectfully requests that the §103(a) rejection of these claims be reconsidered and withdrawn.

#### **Claim 7**

Applicant respectfully submits that Fernandez fails to remedy the above-mentioned deficiencies of Fujii and Cox, with respect to Claim 1. Therefore, Applicant submits that Claim 7 is patentable at least by virtue of its dependence on Claim 1.

Further, Applicant submits that the cited combination of Fujii, Cox, and Fernandez fails to teach or suggest a mail server, as recited in Claim 7. The Examiner acknowledges that Fujii in view of Cox fails to teach or suggest this limitation. (Office Action, p. 8). Therefore, the Examiner relies on Fernandez to teach this limitation. As discussed by the Examiner, Fernandez teaches a mail forwarding system that delivers e-mail to a mobile phone. (Office Action, p.8).

However, Fernandez fails to teach or suggest any ability to permit or not permit the communication of an e-mail, based on a permission or non-permission response or a non-permission flag.

For at least these reasons, Applicant submits that Claim 7 is patentable over the cited combination of references and respectfully requests that the §103(a) rejection of Claim 7 be reconsidered and withdrawn.

**Claim 11**

Applicant respectfully submits that Beach fails to remedy the above-mentioned deficiencies of Fujii and Cox, with respect to Claim 8. Therefore, Applicant submits that Claim 11 is patentable at least by virtue of its dependence on Claim 8.

Further, Applicant submits that the cited combination of Fujii, Cox, and Beach fails to teach or suggest an operation section, a transmitting section, or a receiving section, as recited in Claim 11. The Examiner acknowledges that Fujii in view of Cox fails to teach or suggest these limitations. (Office Action, p. 8) Therefore, the Examiner must rely on Beach to teach these limitations. However, the Examiner fails to make any reference to Beach, and instead asserts that a separate, uncited reference, “Evans,” teaches these limitations.

Regarding the Examiner’s reference to “Evans,” Applicant first notes that the Examiner has failed to meet his burden of presenting a *prima facie* case of obviousness of Claim 11 over Fujii, in view of Cox and Beach. In order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a) the Examiner must show that the prior art references, here Fujii, Cox, and

Beach, when combined, teach or suggest all of the claim limitations. (MPEP § 2143). In this case, the Examiner has failed to show that any of Fujii, Cox, or Beach teaches or suggests an operation section, a transmitting section, or a receiving section, as claimed. Second, Applicant respectfully requests that if the Examiner intends to cite an additional “Evans” reference that he do so in a proper rejection in a new, non-final Office Action.

Additionally, regarding the Beach reference, Applicant submits that like Fujii and Cox, Beach fails to teach or suggest an operation section, a transmitting section, or a receiving section, as claimed. Beach is generally directed to a wireless local area network through which data communication originating in a wired network are routed to mobile units and through with data communications originating in the mobile units are routed to other mobile units or to destinations within the wired network. Beach fails to teach or suggest generating or transmitting download instructions or receiving a replica directory in response to such download instructions. Beach also fails to teach or suggest generating or transmitting download instructions or receiving a replica directory, as required by these limitations. According to Beach, data communication are routed to their proper destinations without any operation by a user or any download instructions.

Therefore, for at least these reasons, Applicant submits that Claim 11 is patentable over the cited combination of references and respectfully requests that the §103(a) rejection of Claim 11 be reconsidered and withdrawn.

AMENDMENT UNDER 37 C.F.R. § 1.116  
U.S. Application No. 09/922,739


Q65752

**Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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**23373**

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Date: October 13, 2004